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10/522,628

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EXAMINER

WALTERS, RYAN J

ART UNIT

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3726

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/522,628	Applicant(s) HANREICH, KLAUS	
	Examiner RYAN J. WALTERS	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/31/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 6 and 11 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. **Claim 6** recites the limitation "matched repair stations" in lines 4-5. It is unclear what a matched repair station is.
4. **Claim 11** recites the limitation "before being disassembled" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1, 9-10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Wortmann (US 5,193,272).**

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7. Re **Claim 1**, Wortmann discloses a method for maintenance of gas turbines, wherein modules 3, 5 of the gas turbines, are inspected and/or repaired, wherein the repair is subdivided into at least two repair steps, wherein modules to be repaired of at least one gas turbine are moved through repair stations 26, 27, 28 in order to carry out the repair steps (Fig. 3; Cols. 5-6).

8. Re **Claim 9**, inherently the modules are inspected after repair.

9. Re **Claim 10**, Wortmann discloses the gas turbines are disassembled into modules 3, 5 before repair (Col. 5, lines 1-30).

10. Re **Claim 12**, inherently gas turbines will be assembled from the repaired modules after repair.

11. Claims 1-4, 6-10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Rathi (US 5,285,572).

12. Re **Claim 1**, Rathi discloses a method for maintenance of gas turbines, wherein modules of the gas turbines, are inspected and/or repaired, wherein the repair is subdivided into at least two repair steps, wherein modules 10 to be repaired of at least one gas turbine are moved through repair stations 30, 32, 48, 50, 52 in order to carry out the repair steps (Fig. 7).

13. Re **Claim 2**, Rathi discloses the modules 10 are repaired in different repair lines containing repair stations, with a decision on the repair line to which a module 10 to be repaired will be sent being made after inspection of the modules (Col. 3, line 35 – Col. 4, line 20).

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14. Re **Claim 3**, Rathi discloses the repair of the modules 10 in each of the repair lines is subdivided into at least two repair steps (Fig. 7).

15. Re **Claim 4**, Rathi discloses the repair lines include at least one of a coating-intensive repair line and a welding-intensive repair line and a non-welding-intensive repair line (Col. 8, lines 43-51).

16. Re **Claim 6**, as best understood, Rathi discloses two or more repair steps are carried out in succession within one repair line (Fig. 7), wherein the modules 10 are moved to at least one matched repair stations 54 in order to carry out the repair steps, wherein each matched repair station 54 includes two or more identical repair stations provided for at least some of the repair steps, such that the same repair steps can be carried out at the same time on different modules within one repair line (Col. 8, lines 43-51).

17. Re **Claim 7**, Rathi discloses in addition to the repair stations in the repair lines, central repair stations 54 are provided, wherein modules 10 from different repair lines are passed to the central repair stations (Col. 8, lines 28-51).

18. Re **Claim 8**, Rathi discloses the central repair stations 54 include at least one of a heat treatment stations a washing station and an electroplating station (Col. 8, line 44).

19. Re **Claim 9**, Rathi discloses the modules 10 are inspected after repair (Col. 3, lines 5-55).

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20. Re **Claim 10**, Rathi discloses the gas turbines are disassembled into modules 10 before repair (Col. 3, lines 17-34).

21. Re **Claim 12**, Rathi discloses gas turbines are assembled from inspected and/or repaired and/or new modules 10 after repair (Col. 8, lines 43-51).

22. **Claims 1-5, 7-10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Sawyer (Turbomachinery Maintenance Handbook, XP-002294741).**

23. Re **Claim 1**, Sawyer discloses a method for maintenance of gas turbines, wherein modules of the gas turbines, are inspected and/or repaired (Page 5-43 “Inspection”),

wherein the repair is subdivided into at least two repair steps,

wherein modules to be repaired of at least one gas turbine are moved through repair stations in order to carry out the repair steps (Page 5-45 “Restoration and Replacement”).

24. Re **Claim 2**, Sawyer discloses the modules are repaired in different repair lines containing repair stations, with a decision on the repair line to which a module to be repaired will be sent being made after inspection of the modules (Page 5-45 “Restoration and Replacement”).

25. Re **Claim 3**, Sawyer discloses the repair of the modules in each of the repair lines is subdivided into at least two repair steps (Page 5-45 “Restoration and Replacement”; such as stop drilling and welding steps for combustor liners).

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26. Re **Claim 4**, Sawyer discloses the repair lines include at least one of a coating-intensive repair line and a welding-intensive repair line and a non-welding-intensive repair line (Page 5-45 "Restoration and Replacement").

27. Re **Claim 5**, Sawyer discloses modules of gas turbines are moved discontinuously on a cycle through the repair stations or the repair lines (Page 5-45 "Restoration and Replacement"; From second column: "Some parts are directly reusable, some must be scrapped and replaced and others which are still serviceable may be restored to original tolerances.").

28. Re **Claim 7**, Sawyer discloses in addition to the repair stations in the repair lines, central repair stations are provided, wherein modules from different repair lines are passed to the central repair stations (lathe, grinding, heat treating, etc.; Page 5-45 "Restoration and Replacement").

29. Re **Claim 8**, Sawyer discloses the central repair stations include at least one of a heat treatment stations a washing station and an electroplating station (heat treating; Page 5-45 "Restoration and Replacement").

30. Re **Claim 9**, Sawyer discloses the modules are inspected after repair (Page 5-47 "Reassembly"; Page 5-48 "Test").

31. Re **Claim 10**, Sawyer discloses the gas turbines are disassembled into modules before repair (Page 5-41 "Disassembly").

32. Re **Claim 12**, Sawyer discloses gas turbines are assembled from inspected and/or repaired and/or new modules after repair (Page 5-47 "Reassembly").

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33. Claims 1-3, 5 and 12 are clearly rejected under 35 U.S.C. 102(e) as being anticipated by Burmeister (PGPub 2006/0272152).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

34. Re Claims 1-3, 5 and 12, see claims 20 and 22 of Burmeister.

Claim Rejections - 35 USC § 103

35. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

36. Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rath (US 5,285,572).

37. Re Claim 5, Rath does not disclose that modules of gas turbines are moved discontinuously on a cycle through the repair stations or the repair lines. However, it would be obvious to one of ordinary skill in the art to move the modules through the repair stations at any desired rate for the purpose of repairing turbines as they are needed in the field.

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38. Re **Claim 11**, Rathl discloses that the modules 10 are cleaned before repair (Col. 3, line 27).

Rathl does not disclose that before being disassembled, the gas turbines are precleaned as a unit. However, it would be obvious to one of ordinary skill in the art to preclean the gas turbines as a unit in order to remove grease and contaminants and thus reduce the amount of grease and contaminants that will accumulate on the repair stations.

39. **Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawyer (Turbomachinery Maintenance Handbook, XP-002294741).**

40. Re **Claim 6**, as best understood, Sawyer discloses two or more repair steps are carried out in succession within one repair line, wherein the modules are moved to at least one matched repair stations in order to carry out the repair steps (Page 5-45 "Restoration and Replacement").

Sawyer does not explicitly disclose that each matched repair station includes two or more identical repair stations provided for at least some of the repair steps, such that the same repair steps can be carried out at the same time on different modules within one repair line.

However, Sawyer discloses that "Restoration techniques vary depending on...the overhaul facilities and equipment available." It would be obvious to one of ordinary skill in the art to utilize multiple stations for repairing more than one of a specific component

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at the same time (such as for welding repair of a combustor liner) for the purpose of expediting repair procedures.

41. Re **Claim 11**, Sawyer discloses that the modules are cleaned before repair (Page 5-41 "Disassembly").

Sawyer does not disclose that before being disassembled, the gas turbines are precleaned as a unit. However, it would be obvious to one of ordinary skill in the art to preclean the gas turbines as a unit in order to remove grease and contaminants and thus reduce the amount of grease and contaminants that will accumulate on the repair stations.

Double Patenting

42. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

43. **Claims 1-3, 5 and 12 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 20 and 22 of copending Application No. 10/544,471.** This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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44. Claims 1-3 and 12 are directed to the same invention as that of claims 20 and 22 of commonly assigned application No. 10/544,471. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

45. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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46. **Claims 1-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 20-38 of copending U.S. Patent Application Serial No. 10/544,471 (hereinafter referred to as '471).**

47. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of '471 "anticipate" the broader claims of the present application. Accordingly, the claims of the present application are not patentably distinct from those in '471. Since it is clear that the more specific '471 claims encompass the claims of the present application, following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN J. WALTERS whose telephone number is (571)270-5429. The examiner can normally be reached on Monday-Friday, 9am-5pm EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. J. W./
Examiner, Art Unit 3726

/DAVID P. BRYANT/
Supervisory Patent Examiner, Art Unit 3726